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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING  
2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
8

9  
10 Ex parte SHUICHI ICHIKAWA,  
11 AIKO OTSUKA,  
12 MOTOMICHI ITOU, and  
13 TAKUMA MAKINO  
14

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16 Appeal 2009-002196  
17 Application 10/505,334  
18 Technology Center 2800  
19

20  
21 Oral Hearing Held: May 13, 2009  
22

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24  
25 Before PETER F. KRATZ, JEFFREY T. SMITH, and  
26 LINDA M. GAUDETTE, Administrative Patent Judges  
27

28  
29 ON BEHALF OF THE APPELLANT:  
30

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1           The above-entitled matter came on for hearing on Wednesday,  
2   May 13, 2009, commencing at 9:46 a.m., at the U.S. Patent and Trademark  
3   Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery,  
4   Notary Public.

5           THE CLERK: Good morning. Calendar Number 17, Appeal Number  
6   2009-2196, Mr. Wilensky.

7           JUDGE KRATZ: Good morning, Mr. Wilensky. How are you today?

8           MR. WILENSKY: Good morning, sir.

9           JUDGE KRATZ: When you're ready, you have about 20 minutes to  
10   make your arguments. If you could, could you please introduce your guest.

11          MR. WILENSKY: Oh, yes. This is Sam Bailey, a colleague from my  
12   law firm. He'll be observing me today.

13          JUDGE KRATZ: Whenever you're ready.

14          MR. WILENSKY: May it please the Court, my name is Moshe  
15   Wilensky. I represent the Appellant in this matter.

16          We ask that this Board overturn the final rejection issued on May 4,  
17   2007, and allow the current claims.

18          The final rejection lacks merit for at least two reasons. First, because  
19   the applied references do not disclose the step of covering the exposed sides  
20   of the honeycomb structure with a heat insulating material as recited in  
21   independent Claim 18; and, second, because it would not have been obvious  
22   to combine the applied references of Kishimoto and Amer, as suggested by  
23   the Office Action.

24          Turning to my first point, independent Claim 18, which is the  
25   independent claim at issue in this appeal, recites a method for measuring  
26   thermoconductivity of a honeycomb structure.

1           The claim recites, in relevant part, a step of contacting the two ends of  
2     the honeycomb structure with contact members, and then covering the  
3     exposed sides of the honeycomb structure with a heat insulating material.

4           Now, neither of the applied references discloses this step of covering  
5     the exposed surfaces with a heat insulating material.

6           JUDGE KRATZ: Excuse me, counselor.

7           MR. WILENSKY: Yes, sir.

8           JUDGE KRATZ: Are you conceding that Kishimoto disclosed a  
9     honeycomb structure?

10          MR. WILENSKY: No, Your Honor, we're not conceding that. We're  
11     choosing to stand on our Brief on the arguments on that issue.

12          JUDGE KRATZ: Which were?

13          MR. WILENSKY: Oh, excuse me. You said Kishimoto discloses?

14          JUDGE KRATZ: Yes.

15          MR. WILENSKY: For the moment, yes, we are conceding that  
16     Kishimoto discloses a honeycomb structure.

17          JUDGE KRATZ: Okay. You can proceed.

18          MR. WILENSKY: Thank you.

19          However, the applied reference in Kishimoto does not disclose  
20     covering this honeycomb structure with a heat insulating material.

21          The obviousness action states that Kishimoto relates to a -- what  
22     happens is a closed cell foam is inserted inside a container. That was  
23     element 1 in the reference.

24          The Office Action appears to assert that this container is the heat-  
25     insulating material that is placed on the exposed surface of the honeycomb.  
26     However, there are two problems with this assertion.

1           The first is that Kishimoto never describes this container as having  
2   any heat insulated properties. In fact, the only discussion that Kishimoto has  
3   of the properties of this container is that it states, and I quote:

4           "It should have a high gas barrier property."

5           The purpose of this container is to maintain the vacuum that is created  
6   in the insulation of Kishimoto, so the Office Action never cites any portion  
7   of Kishimoto as stating that there is heat insulated properties, and our review  
8   of the reference also hasn't shown any such indication.

9           Perhaps more basically, there's a second problem with the assertion  
10   that this container is the heat insulative material. That is that this container  
11   is actually part of the alleged honeycomb structure itself.

12           I draw this Board's attention to Column 13, Lines 9 through 13 of  
13   Kishimoto, which is the section cited by the Office Action as disclosing that  
14   it would be desirous to obtain the thermal properties of the alleged  
15   honeycomb structure.

16           It states: "After the container was sealed, the characteristics of the  
17   obtained thermal insulator were measured," which means the entire structure  
18   -- the foam inside and the container itself all together -- make up the  
19   insulation, which is being tested.

20           Which means the container is part of the alleged honeycomb structure,  
21   which means it can't also then be an issue of material that's wrapped around  
22   each of those surfaces of the honeycomb structure.

23           As such under either interpretation, whether the foam inside is just the  
24   structure, in which case the container is not described as being heat  
25   insulative; or in a more reasonable interpretation that the entire structure is  
26   the honeycomb structure, in which case Kishimoto discloses no such extra

1 material which is covering the exposed sides.

2 Now, the second point we'd like to raise is it wouldn't be obvious to  
3 combine the two references. The reference of Kishimoto to Amer. It  
4 wouldn't be obvious because Amer relates to the testing of thermal  
5 properties of thin films.

6 For example, it describes thin films on the order of 50 to 150 microns  
7 in width. Basically, to put this in perspective, Amer is talking about  
8 obtaining the thermal properties of paint.

9 Amer actually describes taking the contact point and literally painting  
10 on the paint onto that plate and then putting the two plates together.

11 Amer also discloses that other methods are preferable for testing the  
12 properties of thicker materials. In fact, it specifically identifies insulation as  
13 one of those materials.

14 Kishimoto relates to insulation, which means if one of ordinary skill  
15 in the art were looking at the two references, they would look at Amer and  
16 say that Amer itself says that other methods in the art are supposed to be  
17 used for testing thermal properties of insulation.

18 They would have no reasonable belief they could adapt Amer to test  
19 the thermal properties of thicker products.

20 Under the guidelines set forth in the MPEP, since the Supreme Court's  
21 position in KSR, the guidelines state that the steps that need to be followed  
22 to prove that something is obvious to try would be that, first, the prior art  
23 discloses a problem.

24 It discloses a number of finite solutions for that problem, but it also  
25 must show that one of ordinary skill in the art would have a reasonable  
26 expectation of success to apply the references or the solutions to solve the

1 problem.

2 Here Amer relates to testing the properties of thin film, and it has  
3 specific structures that are designed for that. It itself discloses that other  
4 methods and structures would be more effective for testing thicker  
5 properties.

6 We submit that only in hindsight would it have been in any way  
7 obvious for one of ordinary skill to use this particular method to test the  
8 thermal properties of a honeycomb insulator.

9 For all these reasons we ask that this Board overturn the final rejection  
10 and allow the current claims.

11 Does the Court have any further questions?

12 JUDGE SMITH: Claim 18 in the preamble lists that you're measuring  
13 the thermal conductivity of a honeycomb structure.

14 MR. WILENSKY: Yes.

15 JUDGE SMITH: What is the honeycomb structure?

16 MR. WILENSKY: The honeycomb structure in the final specification  
17 refers to a device that's used to clean the exhaust of a car.

18 What you basically have is sort of a circular device with a variety of  
19 long channels that are divided by thin partition walls in an alternating pattern  
20 on either end.

21 These are the typical type of honeycombs that are well known in the  
22 automotive industry.

23 JUDGE SMITH: So would the honeycomb structure include the  
24 container or not?

25 MR. WILENSKY: Well, the honeycomb structure as understood in  
26 the specification has no container because there's no foam or anything in it.

1 It's an extruded clay material that extrudes out from a die in a shape  
2 and then is kiln fired and dried. There's no inside and no outside covering.  
3 There's simply a plurality of these partitioned walls, and then an outer wall.  
4 They're all made out of the clay.

5 There's no separate container and inside foam as are disclosed in the  
6 reference to Kishimoto. That relates to a very, very different type of  
7 honeycomb, if indeed it is a honeycomb.

8 JUDGE SMITH: Do you know what portion of the specification  
9 defines this structure in the way you just described?

10 MR. WILENSKY: In our specification?

11 JUDGE SMITH: Yes.

12 MR. WILENSKY: I don't have a cite off the top of my head, no. If  
13 you'll give me just a moment, I'll have a look.

14 It appears I don't have a copy of our specification. I do apologize.

15 JUDGE SMITH: That's okay.

16 MR. WILENSKY: I do believe it discloses the plurality of petitions  
17 with channels and the wall. I believe it discloses in the background section,  
18 but I'm sorry I don't have a cite, Your Honor.

19 JUDGE KRATZ: Any other questions?

20 JUDGE GAUDETTE: No.

21 JUDGE SMITH: No.

22 JUDGE KRATZ: No further questions. Thank you.

23 MR. WILENSKY: Thank you very much.

24 Whereupon, the proceeding at 9:55 a.m. was concluded.